

**REMARKS**

Claims 1-3, 5-19, 21-35, 37-51, 53-67, 69-84 and 86-153 are pending in this application, and all stand rejected. Claim 65 has been amended herein. No new matter has been added by this paper.

The outstanding Office Action indicates that the use of trademarks in the specification is improper. Claims 17, 21-25, 27, 30-33, 37-41, 43, 44, 46-49, 53-57, 59-60, 62-65, 69-73, 75, 76, 78-82, 86-90, 92, 93, 95-98, 127, 129-141 and 143-153 stand rejected under 35 U.S.C. §112, ¶1 as failing to enable the term "adhesive" because the specification only discloses a single adhesive; maleic anhydride. Claims 65-67 and 69-81 stand rejected under 35 U.S.C. §112, ¶2 because the phrase "the first layer not having an adhesive-free layer directly adjacent thereto other than the first layer" is unclear and confusing. All pending claims stand rejected under 35 U.S.C. §103 as unpatentable over Statutory Invention Registration H1419 to Wilpers et al. ("Wilpers"). Applicants traverse these objections and rejections in light of the amendments herein. Reconsideration of the instant application is respectfully requested.

**I. HISTORY OF 35 U.S.C. §112, ¶1 AND §103 REJECTIONS**

The grounds of the §112, ¶1 rejection (enablement of the term "adhesive") and the §103 rejection (over Wilpers) were both previously levied in this application in the Office Action of September 24, 2002 (See numbered pars. 1, 7 and 9) and overcome. Specifically, Applicants responded to those rejections in a January 13, 2003 AMENDMENT UNDER 37 C.F.R. §1.111. On

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April 9, 2003 Applicants filed a SUPPLEMENTAL RESPONSE RE: §112, FIRST PARAGRAPH REJECTION providing further arguments rebutting the §112, ¶1 rejection and submitting a 1.132 DECLARATION OF DR. ROBERT KNOLL in support of those arguments. On June 11, 2003, the Office mailed a NOTICE OF ALLOWANCE AND FEE(S) DUE accepting the claims in light of the arguments presented in the papers of January 13 and April 9. Although Applicants filed a Request For Continued Examination on July 14, 2003 to get additional prior art before the Office, the rejections raised by the September 24, 2002 Office Action had been resolved.

Nearly eighteen months (18) after they were originally asserted, the outstanding March 5, 2004 Office Action resurrects the very same rejections under §112, ¶1 and §103 propounded in the September 24, 2002 Office Action against the identical claims for which Applicants argued and gained allowance through its January 13, 2003 and April 9, 2003 papers.

The outstanding rejection repeats the §112, ¶1 rejection recited in the September 24, 2002 Office Action. No mention is made of Applicants substantial arguments set forth in their January 13, 2003 amendment and their April 9, 2003 response providing thirteen pages (13) of additional arguments, and a seven (7) page §1.132 declaration, dedicated exclusively to the §112, ¶1 rejection now resurrected.

While the outstanding rejection indicates that the Applicants argument with respect to Wilpers, but not the §112, ¶1 rejection, have been considered but are not deemed persuasive (See numbered paragraph 9), it provides no new ground of rejection or any indication why the claims

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(previously allowed over Wilpers) are again rejected on the very same grounds previously overcome by Applicants.

The outstanding rejections roll the clock back eighteen months on the instant application (September 2002 – March 2004).

## **II. SPECIFICATION**

The outstanding office action indicates that the use of the trademarks Morton EFM-2E02 in Examples 1 and 3 as well as Mitsui Admer QB510A in Example 10 in the specification is improper because these trademarks are not defined. The office action indicates that these trademarks should be capitalized wherever used and be accompanied by the generic terminology. Applicants have amended the specification accordingly and respectfully request an indication that the amended specification is proper.

## **III. REJECTIONS PURSUANT TO 35 U.S.C. §112, ¶1**

Claims 17, 21-25, 27, 30-33, 37-41, 43, 44, 46-49, 53-57, 59-60, 62-65, 69-73, 75, 76, 78-82, 86-90, 92, 93, 95-98, 127, 129-141 and 143-153 stand rejected under 35 U.S.C. §112, ¶1 as failing to enable the term “adhesive” because the specification only discloses a single adhesive; maleic anhydride. The rejection states:

Applicant only discloses maleic anhydride as the “adhesive” [sic]  
Therefore, one having ordinary skill in the art would not have known

what other materials could be used in Applicant's invention as an "adhesive" for bonding layers.

While recognizing that the specification states "an appropriate adhesive is chosen dependent upon the material of the middle layer 26 to bond the inner and outer layers 24, 28 thereto" the rejection states that since the specification only discloses polypropylene (PP) and EVOH or nylon as being bonded by the maleic anhydride and has not therefore clearly enabled the bonding of PP and EVOH or nylon with anything other than maleic anhydride. This is, *verbatim*, the same argument addressed in Applicants January 13, 2003 and April 9, 2003 papers; including the 1.132 DECLARATION OF DR. ROBERT KNOLL.

Applicants January 13, 2003 and April 9, 2003 papers, set forth numerous substantial arguments rebutted this rejection based on several grounds; including, as evinced by the declaration of Dr. Knoll, that one of ordinary skill in the art would have understood, from the teachings of this application, other materials that could be used with the invention. The outstanding office action fails to address or even recognize the January 13, 2003 and April 9, 2003 arguments rebutting this §112, ¶1 rejection. For these reasons, Applicants have a good faith belief that Applicants' arguments were not considered when the outstanding office action was issued. Accordingly, Applicants incorporate those arguments herein by reference and respectfully contend that re-asserting those arguments represents a *bona fide* good faith attempt to advance the instant application to final action.

If the §112, ¶1 rejection is continued, then Applicants respectfully request an indication why Applicants' positions presented in the January 13, 2003 and April 9, 2003 papers failed to overcome that rejection.

Subsequent to Applicants' January 13, 2003 and April 9, 2003 papers, the Federal Circuit addressed an issue similar to that presented by the outstanding §112, ¶1 rejection. In *Northrop Grumman Corp. v. Intel Corp.*, the Federal Circuit considered the scope of teaching provided by a claim element used throughout the specification in broad and general terminology, but also taught as having a specific embodiment. 325 F.3d 1346 (Fed. Cir. 2003) Rejecting the contention that reference to specific a embodiment would limit the scope of that broad element, the *Northrop Grumman* Court stated:

None of those statements, however, constitutes a limitation on the scope of the invention. [] Absent a clear disclaimer of particular subject matter, the fact that the inventor may have anticipated that the invention would be used in a particular way does not mean that the scope of the patent is limited to that context.

(325 F.3d 1346, 1355 (Fed. Cir. 2003)) Here, there is no disclaimer. To the contrary, one of ordinary skill in the art, such as Dr. Knoll, would understand the broad term adhesive taught adhesives, other than the preferred embodiment, as susceptible of use with the invention. It is the understanding of the artisan possessing ordinary skill that controls.

**IV. REJECTIONS PURSUANT TO 35 U.S.C. §112, ¶2**

Claims 65-67 and 69-81 stand rejected under 35 U.S.C. §112, ¶2 based on the assertion that the phrase “the first layer not having an adhesive-free layer directly adjacent thereto other than the first layer” is unclear and confusing. Applicants have amended the claim 65 to rewrite the language on which this rejection is based as “the second layer being the only layer free of adhesive residing directly adjacent to the first layer.” Applicants assert that this amendment has clarified claim 65 without narrowing its scope.

The phrase “the second layer being the only layer free of adhesive residing directly adjacent to the first layer” is intended to indicate that the first layer does not have another adhesive free layer directly adjacent thereto. Accordingly, the first layer could have no layer at all on the side opposite the side on which the second layer resides. Alternatively, the first layer could have a third layer on the side opposite the side on which the second layer resides, with the third layer comprising an adhesive.

Given this construction, claim 65 defines around the first layer being a typical tie layer in the common container structure which comprises an outer support layer of structural material (e.g. polypropylene) tied to an inner oxygen barrier layer by a tie layer comprising a blend of structural polymer and an adhesive. Because there can be no adhesive-free layer directly adjacent to the first layer, with the sole exception of the second layer, the typical structural layer comprising exclusively structural material is precluded.

**V. REJECTIONS PURSUANT TO 35 U.S.C. §103**

**A. Adhesive Amount**

The Office Action states the following:

Although Wilpers does not specifically teach the claimed amount of maleic anhydride, it would have been obvious to one having ordinary skill in the art to have varied the amount of maleic anhydride grafted to the polybutylene to have varied provided varying degrees of adhesion to the polar substrates. Therefore, the amount of maleic anhydride (about 0.01 to about 0.20 percent by weight) would have been known or easily determined by one having ordinary skill in the art since it provides the function of adhering a polypropylene to an EVOH or nylon layer, as does Applicant's claimed invention.

The rejection expressly recognizes that Wilpers does not teach the claimed amount of maleic anhydride, but rejects the claims on the assertion that it would have been obvious for one of ordinary skill in the art to try varying amounts of maleic anhydride to reach the claimed invention. However, Wilpers does not provide any direction or discussion of how to arrive at a desired amount of adhesive, or how it will impact other characteristics of the product constructed from the disclosed composition. Thus, this rejection amounts to the very type of rejection that the Federal Circuit deemed to constitute an "obvious to try" rejection long ago ruled to be improper. The Federal Circuit's *In re O'Farrell* opinion, in an attempt to clarify what constituted the improper "obvious to try" standard, stated that it is improper to reject a claim where obviousness is based on:

vary[ing] all parameters or try[ing] each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. (853 F.2d 894,903 (Fed. Cir. 1988))

Here, Wilpers fails the very basic requirement of inviting the reader to experiment with the levels of adhesive. Indeed, Wilpers fails to suggest that varying amounts might prove beneficial for any purpose or even that varying the level of adhesive would provide certain results, with or without suggestions of beneficial results. Clearly, then, Wilpers provided “no indication of which parameters were critical or...which of many possible choices is likely to be successful.” The improper nature of the rejection is shown by the rejection itself which fails to reference a single portion of the Wilpers specification to support the conclusion that Applicants’ claimed amount of adhesive is obvious.

Moreover, since Wilpers makes no mention of employing his composition for biaxially oriented containers, it cannot teach or render obvious the claimed amounts of adhesive of claims 1-98 which are stretch blow molded and thus biaxially oriented containers. The Office Action specifically recognizes that Wilpers provides no teaching of a biaxially oriented container by asserting that it would have been obvious to apply the teachings of Wilpers to biaxially oriented containers. Thus, this portion of the obviousness rejection requires that Wilpers set off two separate and sequential understandings for one of ordinary skill in the art. First, the skilled artisan must make the mental leap that Wilpers’ composition is appropriate for application in biaxially oriented containers. Then, that artisan must make the additional and subsequent mental



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leap to experiment with varying amounts of adhesive (which step is an improper basis for rejection as discussed above) to arrive at the claimed amounts of adhesive appropriate for biaxially oriented containers. The necessity of multiple mental steps speaks against obviousness.

Applicants respectfully assert that the test under §103 is not what “one might contemplate,” but whether the references, taken as a whole, would suggest the invention to one of ordinary skill in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, \_\_\_\_ (Fed. Cir. 1983). Here, Wilpers in no way “suggests” using the claimed amount of adhesive; let alone in an application to biaxially oriented containers which find no mention in the teachings of Wilpers.

Similarly, Wilpers provides no discussion whatsoever, let alone a teaching, of haze or how haze may be effected by adhesive. Applicants again respectfully assert that such a rejection is a direct application of the improper “obvious to try” standard.

Considered individually, it might be easy for the Office to assert that each element is obvious in light of Wilpers. But taken together, it is telling that Wilpers is deficient in any teaching of (1) the amounts of adhesive, (2) the biaxial stretching that would figure into the amount of adhesive, or (3) the haze of products resulting from an application of Wilpers’ composition. Taken together, the absence of any teaching or suggestion whatsoever of these features prevents a proper finding of obviousness.

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**CONCLUSION**

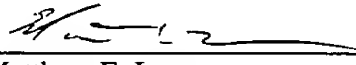
Applicants submit that this application is in condition for allowance. Early action to that end is respectfully requested.

Respectfully submitted,

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